

### **REMARKS/ARGUMENT**

**The listing of Claims and Amendments thereto are attached as Appendix 1**

#### ***Objection as to Drawings***

The Examiner has objected to the drawings stating the subject matter in claim 6 is not shown and must be shown or the feature must be cancelled from the claims.

Applicant states that claim 6 has been cancelled and thus no change to the drawings need be affected.

#### ***Claim Rejections 35 USC §112***

The Examiner has rejected claims 19, 20 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, since the phrase “the appendage securing section” lacks proper antecedent basis.

#### **Response:**

In Response, applicant asserts that the phrase “the appendage securing section” appears several times throughout the specification and claims of the instant application. Particularly, the phrase “the appendage securing section” appears with great detail within paragraphs [0040] - [0041].

In fact within paragraph [0040], Applicant asserts that the phrase “[a]s shown in Figs. 1-5 the appendage securing section” is even mapped with the exact configuration

within the drawings stating: "appendage securing section 1 could have a first end 4 and a second end 5" Specification, paragraph [0400].

Further, as illustrated above, applicant has amended claims 19 and 20 in order to meet with the Examiner's rejection regarding antecedent basis as illustrated above.

***Claim Rejections 35 USC §102***

The Examiner has rejected claims 1-3, 5, and 7-18 under 35 U.S.C. 102(b) as being anticipated by Kawasaki, et al., U.S. Patent No. 5,486,194 (hereinafter "Kawasaki") As noted by the Examiner, 35 U.S.C. 102(b) states that:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Therefore, Applicant's invention will be unpatentable only if each and every element claimed in the application is disclosed by Kawasaki.

**Response:**

Kawasaki does not disclose each and every element of Applicant's invention. The Examiner asserts generally that Kawasaki teaches a device capable of prevention of abnormal joint rotation. However, there is no supporting evidence of this assertion. "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1990) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214) (C.C.P.A. 1981) (emphasis added). There is absolutely nothing in the teaching disclosed by Kawasaki to indicate that it is capable of doing anything remotely similar to

the correcting pressure achieved by Applicant's device. The Examiner has cited to no figure or page number to support the assertion, and the reason for this is simply that none exists. Therefore, there can be no anticipation based on the unsupported assertion that the band of Kawasaki is capable of countering the direction of the abnormal joint rotation. It shall also be noted that there are no specific 102(b) rejections made for claims 1-3, 5, or 8-12 other than the general comments on page 2. Regardless, the arguments contained herein should be sufficient to overcome any rejections of these claims, whether general or specific.

With regard to claim 7, Kawasaki claims a band made of non- or low-stretchable fiber. Applicant's claim 7 recites an "elastic material." Therefore, Kawasaki teaches an element that is distinctly different from elastic, i.e. non or low stretchable fiber. The limitation of Kawasaki, thus, can not be said to meet the "each and every element" requirement of 35 U.S.C. 102(b).

Regarding claim 13, the Examiner's contention that Kawasaki includes an appendage securing section that has a first end and a second end, and a torso securing section that has a first end, and intermediate section and a securing end is simply not accurate. To the contrary, Kawasaki discloses a single band that has one end that includes projections, and the other end portion of the band that can be thrust on said projections. Kawasaki, col. 4, lines 50-55, and col. 17, line 10. Because the band of Kawasaki is limited to a single band with only two ends, it is impossible for Kawasaki to disclose an appendage securing section that has a first end and a second end, and a torso securing section that has a first end, and intermediate section and a securing end. Therefore, Kawasaki does not anticipate these elements of Applicant's invention.

Applicant's invention, as recited in claim 16 discloses the addition of a coupling means to the device. Claim 18 discloses that the device may be joined together to form a single band wrap. These embodiments, along with simple claim differentiation principles illustrate once again that Kawasaki does not come close to teaching Applicant's invention. As claimed and depicted in Applicant's drawings, figures 1-4, the torso section and the appendage section are separate elements. Kawasaki claims a single band, therefore, the anticipation analysis may end with claim 1 of Kawasaki. The dependent status of the remainder of Applicant's claims make them immune to any possibility of anticipation by Kawasaki as well, because if the independent claim elements are not anticipated, claims depending therefrom can not be anticipated either.

Additionally, the instant device" aids in external use and in preventing pain of external or internal rotation of the hip, whereas; Kawaski aids in internal use only. Furthermore, the instant belt is made of neoprene, with a hook and loop structure, wherein the neoprene promotes warmth and blood flow that aids the healing process of internal or external rotation of the hip.

Moreover, Kawaski illustrates a compressive hemostatic belt designed to halt bleeding from a catheter insertion wound upon completion of an arterial catheter examination. Also, Kawaski possesses a balloon with a pressure gauge, a fluid fed pump at the catheter insertion, a pressure, gauge, a balloon, and located behind the balloon is a non-elastic, reinforcing member being formed from a plurality of non-elastic fibrous sheet layers. Buckles to attach to said belt are illustrated and the belt is only utilized to house the balloon, pump and gauge at the catheter insertion.

Applicant asserts the following argument to the Examiner's rejection of claim 1, 3, 11, 12. The wrap of Hori, et al. U.S. Patent No. 5,464,420 (hereinafter "Hori") is not wrapped at least once around the thigh prior to attaching to the torso securing section. Similar to the device of Kawasaki, the device of Hori is wrapped in an X-shaped fashion, around the thigh, and does not include an initial revolution around the thigh as claimed and illustrated by Applicant's invention. More importantly, the device of Hori is simply incapable of providing the corrective forces necessary to prevent the abnormal joint rotation as provided by Applicant's device.

The Examiner has rejected claims 4, and 6 as being unpatentable under 35 U.S.C. 103(a). As noted by the Examiner, 35 U.S.C. 103(a) states that:

a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Therefore, Applicant's invention will be unpatentable if the differences between it and the information disclosed in the patents cited are such that Applicant's invention would have been obvious.

**Response:**

The Examiner has rejected claim 4 as being unpatentable over Kawasaki in view of U.S. Patent No. 5,993,375 to Engel (hereinafter "Engel"). The Examiner's argument is valid if, and only if, the previous arguments with regard to the disclosure of Kawasaki are valid. As has been shown, the disclosure of Kawasaki is so divergent from Applicant's

invention that the simple addition of Engel, a patent that discloses the use of magnets, can not render Applicant's invention obvious.

The Examiner has rejected claim 6 as being obvious because Kawaski's device could arguably be used on a shoulder joint. Claim 6 has been cancelled and is thus removed from consideration.

***Allowable Subject Matter***

The Examiner has stated that claims 19 and 20 would be allowable if rewritten to overcome the 35 USC §112 rejections. As illustrated above, applicant has amended the claims in order to comply with the Examiner's rejections and as such, claims 19 and 20 are in condition for allowance.

Reconsideration and further examination is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 12-0115.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Adam Bruno, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above remarks and arguments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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## **APPENDIX 1**



***Listing of Claims:***

The listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims

1. (Original) A device for prevention of the abnormal joint rotation, comprising:
  - an appendage securing section constructed and arranged to secure to the  
appendage having the abnormal joint rotation;
  - a torso securing section having means for coupling to the appendage securing  
section, wherein the torso securing section is constructed and arranged to  
secure to the torso of the patient and to apply correcting pressure directed  
upon the appendage securing section, wherein the correcting pressure  
exerted by the torso securing section upon the appendage securing section  
counters the direction of the abnormal joint rotation.
2. (Original) The device of claim 1 wherein:
  - the torso securing section is constructed and arranged to secure to the torso of the  
patient and to apply correcting pressure upon the appendage securing  
section, where in the correcting pressure exerted by the torso securing  
section upon the appendage securing section counters the direction of the  
external rotation of the joint.
3. (Original) The device of claim 1 wherein:
  - the torso securing section is constructed and arranged to secure to the torso of the  
patient and to apply pressure upon the appendage securing section,

wherein the correcting pressure exerted by the torso securing section upon the appendage securing section counters the direction of the internal rotation of the joint.

4. (Original) The device of claim 1 wherein:

the torso securing section has means for affixing upon it of at least one magnetic body.

5. (Original) The device of claim 1 wherein:

the appendage suffering from the abnormal joint rotation is a leg, wherein the joint having the abnormal rotation is a hip.

6. (Cancelled) The device of claim 1 wherein:

the appendage suffering from the abnormal joint rotation is an arm, wherein the joint having the abnormal rotation is a shoulder.

7. (Original) The device of claim 1 wherein:

the torso securing section is composed of an elastic material.

8. (Original) The device of claim 1 wherein:

an appendage securing section constructed and arranged to secure to a thigh of a leg having the abnormal rotation of the hip; and a torso securing section is constructed and arranged to secure to the torso of the patient and to apply correcting pressure directed upon the appendage securing section, wherein the correcting pressure exerted by the torso securing section upon the appendage securing section counters the direction of the abnormal rotation of the hip.

9. (Original) The device of claim 8 wherein:

the torso securing section is constructed and arranged to secure to the torso of the patient and to apply pressure upon the appendage securing section, wherein such pressure is inwardly directed in relation to the hip having external rotation with a result of prevention of the external rotation of the hip.

10. (Original) The device of claim 8 wherein:

the torso securing section is constructed and arranged to secure to the torso of the patient and to apply pressure upon the appendage securing section, wherein such pressure is simultaneously inwardly, frontally and upwardly directed in relation to the hip having external rotation with a result of prevention of the external rotation of the hip.

11. (Original) The device of claim 8 wherein:

the torso securing section is constructed and arranged to secure to the torso of the patient and to apply pressure upon the appendage securing section, wherein such pressure is outwardly directed in relation to the hip having internal rotation with a result of prevention of the internal rotation of the hip.

12. (Original) The device of claim 8 wherein:

the torso securing section is constructed and arranged to secure to the torso of the patient and to apply pressure upon the appendage securing section, wherein such pressure is simultaneously outwardly, rearwardly and

upwardly directed in relation to the hip having internal rotation, with a result of prevention of the internal rotation of the hip.

13. (Original) The device of claim 1 wherein:

the appendage securing section has a first end and a second end; and  
the torso securing section has a first end, an intermediate section, and a securing end, wherein the securing end of the torso securing section has means for coupling to the appendage securing section.

14. (Original) The device of claim 13 wherein:

the appendage securing section has means for coupling of the first end of the appendage securing section to the second end of the appendage securing section.

15. (Original) The device of claim 13 where in:

the first end of the appendage securing section is coupled to the second end of the appendage securing section.

16. (Original) The device of claim 13 wherein:

the torso securing section has means for coupling of the first end of the torso securing section to the intermediate section of the torso securing section.

17. (Original) The device of claim 13 wherein:

the first end of the torso securing section is coupled to the intermediate section of the torso securing section.

18. (Original) The device of claim 13 wherein:

the second end of the appendage securing section is joined to the first end of the torso securing section thereby forming a wrap.

19. (Currently Amended) A method of prevention of the external rotation of the hip by providing directed pressure upon a leg suffering from the external rotation of the hip, using a wrap comprising:

~~the~~ an appendage securing section having a first end and a second end;

~~the~~ a torso securing section having a first end, an intermediate section and a

securing end, wherein the securing end of the torso securing section has

means for coupling to the appendage securing section; and

wherein the second end of the appendage securing section is joined to the first end

of the torso securing section;

said method comprising:

a) placing the first end of the appendage securing section of the wrap against an inside of patient's thigh of the leg suffering from the external rotation of the hip, wherein the appendage securing section of the wrap is positioned in front of the thigh;

b) wrapping the appendage securing section of the wrap at least once around the thigh;

c) wrapping the torso securing section at least once around patient's torso by bringing the torso securing section of the wrap up and over the lateral side of the hip suffering from the external rotation of the hip, over patient's lower back, and over patient's lateral side which lateral side is opposed to the side suffering from the external rotation of the hip; and

d) coupling of the securing end of the torso securing section of the wrap to the appendage securing section at the front of the thigh.

20. (Currently Amended) A method of prevention of the internal rotation of the hip by providing directed pressure upon a leg suffering from the internal rotation of the hip, using a wrap comprising:

~~the~~ an appendage securing section having a first end and a second end;

~~the~~ a torso securing section having a first end, an intermediate section, and a

securing end, wherein the securing end of the torso securing section has means for coupling to the appendage securing section; and

wherein the second end of the appendage securing section is joined to the first end of the torso securing section;

said method comprising:

a) placing the first end of the appendage securing section of the wrap against an outside of patient's thigh of the leg suffering from the external rotation of the hip, wherein the appendage securing section of the wrap is positioned in front of the thigh;

b) wrapping the appendage securing section of the wrap at least once around the thigh;

c) wrapping the torso securing section at least once around patient's torso by bringing the torso securing section of the wrap up and over the front of ht thigh and over the abdomen, over patient's lateral side which lateral side is opposed to the side suffering from the internal rotation of the hip, and over patient's lower back; and

d) coupling of the securing end of the torso securing section of ht wrap to the appendage securing section at the front of the thigh.